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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 40

Application Number: 08/856,944
Filing Date: May 15, 1997
Appellants: Eduard Hoffmann et al

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EXAMINER'S ANSWER

This is in response to Appellants' Brief on Appeal filed June 23, 2000.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying that **there are no related appeals and interferences** which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Claims on Appeal

This appeal involves claims 1-17.

Claims 8, 12, 14, 16, and 17 have been amended subsequent to the final rejection.

(4) Status of Amendments After Final

The Appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

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(6) *Issues*

The Appellants' statement of the issues in the brief is substantially correct. However, given Appellants' grouping of the claims, as set forth below, the Issues before the Board are as follows:

- 1) Whether claim 1 is unpatentable over the teachings of Köbler et al, in view of Fantoni et al, Johnson, Tittgemeyer, and the acknowledged prior art under 35 USC 102(f) or (g).
- 2) Whether claim 1 is unpatentable over the teachings of Tittgemeyer in view of Johnson, Kobler et al, Fantoni et al, and the acknowledged prior art under 35 USC 102(f) or (g).

(7) *Grouping of Claims*

The rejection of claims 1-17 stand or fall together because Appellants' brief includes a statement on page 10, item VII, that the claims do stand or fall together.

(8) *ClaimsAppealed*

The copy of appealed claim 1 contained in the Appendix to the brief is correct. The copy of the remaining claims in the appendix were not checked for accuracy as all claims stand or fall with claim 1.

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(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claim 1 under appeal.

Number	Name	Date
5488903	Köbler et al	02-1996
4964338	Fantoni et al	10-1990
1690684	Johnson	11-1928
4913048	Tittgemeyer	04-1990

(10) Grounds of Rejection

Claim 1 is rejected under 35 U.S.C. 103 as being obvious over Köbler et al in view of Fantoni et al, Johnson, and Tittgemeyer. This rejection is set forth in a prior Office Action, namely, the Final Rejection mailed 4/27/1999, Paper No. 30.

Alternatively, using the same grounds of rejection, claim 1 is rejected under 35 U.S.C. 103 as being obvious over Tittgemeyer in view of Johnson, Köbler et al, Fantoni et al, and the acknowledged prior art under 35 U.S.C. 103(f) and (g).

Initially, it is noted that Applicants' disclosure as originally filed states that the use of a laser for the welding process to make the claimed device and in the method claimed is known prior art (page 7, paragraphs 2 and 3). Specifically, "Figure 2 shows possible ways of producing the carrying sleeve 1 in a quasi-continuous

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fashion, as is currently known by those in the tube welding art. The welding process itself is carried out by a laser beam. ...The carrying sleeves may also be produced by means of the welding device known from DE 43 11 078. The external surface of the welded carrying sleeve 1 is then processed to create a homogeneous, continuous outer surface. To carry out this surface processing, it is possible to use known production methods for smoothing a metal surface, such as turning, polishing or the like.” Further, Applicants state that the processing is known prior art (page 8, paragraph 1). Specifically, “For use in offset printing as the carrying sleeve 1 for a printing form, the entire sleeve surface, including the connecting seam, in the present case a welded seam 2, is subsequently chemically roughened, anodized and provided with a final photosensitive coat, as is already known from the process steps during printing plate production. In respect to technical printing characteristics, this printing form sleeve is identical to conventional printing plates, except that this printing form sleeve permits continuous printing.” So, the sleeve is admitted known prior art and the method of making is admitted known prior art. Applicants’ sole contribution being that such a plate , as produced, is used for continuous printing - page 8, lines 4-6. Therefore, the question before the Examiner is whether or not the prior art teaches or renders

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obvious the use of a continuous metal sleeve for continuous printing. At the very least, such is clearly taught by Tittgemeyer (US Patent No. 4913048) who teaches endless, offset printing via an endless sleeve which is air mounted, that allows for endless printing because it has no interruption due to its seam. Given that Tittgemeyer is silent as to how the sleeve is formed, it would have been obvious to one of ordinary skill in the art to have looked to the prior art for guidance. Methods of forming continuous metal sleeves and such sleeves is acknowledged prior art by Applicants, and is taught by the references relied upon. Köbler et al (US Patent No. 5488903) teach welding metal seams together to form a continuous sleeve for a plate and gas expansion loading of such a formed sleeve on a form cylinder. Johnson (US Patent No. 1690684) teaches typical welding processes including turning and machining to achieve a smooth, continuous final product. Fantoni et al (US Patent No. 4965338) teach the provision of continuous plates via filling and/or adhesive joining to form completely continuous surfaces, where Köbler et al teach the functional equivalency of welding and adhesive connections (column 2, lines 58+).

This does not constitute a new grounds of rejection, as per MPEP 1208.01, as such is a mere change in rationale based on the same evidence/teachings of the prior art.

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(11) Response to Argument

The following remarks have been copied from the First Action Final Rejection mailed 9/17/1999, paper # 35.

"It is further noted that Applicants have only separately argued the references relied upon by the Examiner which does not fairly or accurately address the rejections actually made, and hence renders Applicants' arguments completely non-persuasive. In summary, the prior art teaches the use of continuous metal sleeves as plates in continuous offset printing. The prior art teaches welding a metal sheet together to form such a metal sleeve. The prior art teaches that the weld be concave so that the seam is completely filled. The prior art teaches finishing the weld seam by turning or machining so as to have a completely smooth continuous sleeve. The prior art teaches the use of chemicals to roughen, anodize, etc. the plate surface. The prior art teaches the use of a laser to make the weld. The prior art teaches the disadvantage of a clamp or seam on a printing cylinder in offset printing. Applicants have not claimed any feature or contribution to the art that non-obviously distinguishes over the prior art of record. Applicants have presented broad concept claims that are clearly not allowable over the prior art of record. Applicants have advanced no arguments or reasoning to distinguish over the prior art."

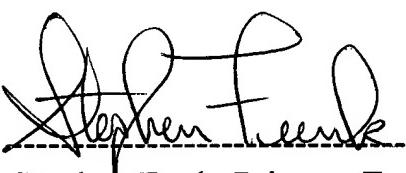
In the Brief filed 6/23/2000, Appellants' again, ONLY separately argue the references relied upon in the first obviousness rejection of claim 1 - which is improper. Appellants' did not respond to the alternative obviousness rationale on the same grounds but relying upon Tittgemeyer as the base reference, as was set forth in the First Action Final Rejection mailed 9/17/1999, which is called the alternative 35 U.S.C. 103 rejection above, under "Grounds of Rejection".

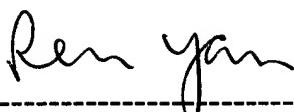
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Kimberly L. Asher
Primary Examiner
Examiner of Record


Stephen Funk, Primary Examiner
Conferee


Ren Yan
Primary Examiner
Conferee

September 7, 2000